

REMARKS

Claims 1-7 and 9 are currently pending.

I. The Enablement Rejection under 35 U.S.C. 112

Claims 1-7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as the specification allegedly does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The Examiner's position is that Applicants' specification is enabling for the claimed invention if the following are included:

a methacrylic resin film having a thickness of 10 to 300 microns;
5 to 45 wt% of acrylic crosslinked elastic particles (B), and
0.05 to 20 parts by weight of a polyfunctional monomer including two or more
non-conjugated double bonds per a molecule.

The Examiner points to Applicants' specification, page 12, paragraph 0023, for his requirement of 0.05 to 20 parts by weight of a polyfunctional monomer including two or more non-conjugated double bonds per a molecule.

Paragraph [0023] reads:

The amount of the polyfunctional monomer to be added in the acrylic crosslinked elastic particles (B) of the present invention is preferably 0.05 to 20 parts by weight, and further preferably 0.1 to 10 parts by weight, per 100 parts by weight of the monomer mixture (b). When the amount of the polyfunctional monomer to be added is less than 0.05 parts by weight, shock resistance and

bending-fracturing resistance of the film that can be formed from the methacrylic resin composition tend to decline, and when the amount is more than 20 parts by weight, shock resistance and bending-fracturing resistance tend to decline as well. (Emphasis added.)

The Examiner points to Applicants' specification, page 14, paragraph 0027, for his requirement of 5 to 45 wt% of acrylic crosslinked elastic particles (B).

Paragraph [0027] reads:

The acrylic crosslinked elastic particle (B) content in the present invention is preferably 5 to 45 wt%, further preferably 10 to 40 wt%, and still further preferably 15 to 35 wt%, when the methacrylic entire resin composition (C) is considered as 100 wt%. When the acrylic crosslinked elastic particle (B) content is less than 5 wt%, shock resistance and bending-fracturing resistance of the film that can be formed from the obtained methacrylic resin composition tend to decline, and when it is more than 45 wt%, film hardness and moldability tend to decline. (Emphasis added.)

The Examiner points to Applicants' specification, page 21, paragraph 0045, for his requirement of methacrylic resin film having a thickness of 10 to 300 microns

Paragraph [0045] reads:

The thickness of the film obtained from the methacrylic resin composition (C) of the present invention is preferably 10 to 300 μm , and further preferably 10 to 200 μm . When the thickness of the film is less than 10 μm , workability of the

film tend to decline, and when the thickness of the film is more than 300µm, transparency of the film to be obtained tend to decline. (Emphasis added.)

From paragraphs [0023], [0027] and [0045], the Examiner concludes that the recitations: a methacrylic resin film having a thickness of 10 to 300 microns; 5 to 45 wt% of acrylic crosslinked elastic particles (B), and 0.05 to 20 parts by weight of a polyfunctional monomer including two or more non-conjugated double bonds per a molecule are “critical to the invention.”

Contrary to indicating that the subject matter of the Examiner’s requested amendments are “critical to the invention”, each of the paragraphs cited by the Examiner clearly states that the recitations are preferable embodiments. And each of the paragraphs cited by the Examiner clearly states that using the preferable embodiments only “tend to” improve properties. “Tend to” simply and unequivocally does not have the same meaning as “critical to.” The terms “preferable” and “tend to” are not clear and strong warnings not to use the non-preferable embodiments. Features which are merely preferred are not considered to be critical. As set forth in MPEP 2164.08(c):

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the

abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Other than noting that Applicants have presented “preferable” embodiments, the Examiner has not provided any legal or scientific argument to support his finding of non-enablement.

Further, the relevant concern in determining the breadth of a claim relevant to the enablement of the disclosure is whether the scope of the enablement provided to one skilled in the art by the disclosure is commensurate with the scope of the protection sought by the claims. The inquiry is to determine how broad the claim is with respect to the disclosure and to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also MPEP 2164.01. The Examiner has not set forth any analysis as to why one skilled in the art would not have been able to make and use Applicants’ invention as currently claimed. The Examiner has also not set forth any analysis as to why undue experimentation would be required. The lack of the Examiner considering any of the *Wands* factors is conspicuously absent.

All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. The scope of enablement must only bear a reasonable correlation to the scope of the claims.

For the above reasons, it is respectfully submitted that Applicants' specification provides a fully enabling disclosure for the invention, as claimed, and it is requested that the rejection under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

II. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the rejection under 35 U.S.C. §112 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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